

6. Claim 8 currently stands rejected under 35 U.S.C. §112, second paragraph.

Claim 8 has been amended.

7-8. The withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 3, 7, 9 and 11 is noted and appreciated.

9-10. Claims 1, 8-9 and 12 currently stand rejected for allegedly being obvious in view of the '163 Application in combination with the subject matter disclosed in U.S. Patent 4,364,882 to Doucet (hereinafter "Doucet").

It is recognized that the '163 Application does not disclose the use of a thermoplastic material and air cooling (Official Action, pg. 4). It is then alleged that a skilled person at the time of the present invention would have replaced the thermosetting material disclosed in the '163 Application, with thermoplastic material as disclosed in Doucet. (Official Action, pg. 5).

Doucet discloses a method of manufacturing plastic pipe for use as a sewage or rainwater pipe (col. 1, lines 10-15; col. 4, lines 8-13)). The plastic pipe disclosed in Doucet includes an inner thermoplastic layer, a foam layer and an outer thermoplastic layer (col. 3, lines 8-20). A fair and proper reading of Doucet reveals that Doucet neither discloses nor suggests the use of a syntactic foam insulation, or anything to do with insulated pipelines of the type disclosed in the '163 Application and claimed by the present application. Doucet simply relates to below ground sewer and drainage pipe. Doucet has nothing to do with thermally insulated pipe. Of course thermal insulation is not even a consideration in a sewage or drainage pipe, because only waste is flowing through the pipe. Accordingly, a person working in the field of thermal insulation for

pipelines, would not look to the field of below ground sewage pipes. In addition, Doucet relates to the field of manufacturing a pipe. In contrast, the present invention relates to applying a thermal insulating coating to a length of pipe (i.e., the pipe already exists).

It is alleged that "...Doucet is at least reasonably pertinent to the particular problem with which the applicant is concerned. Doucet, '163 and applicant are all concerned with the overall problem of providing a pipe with an outer plastic layer over an inner foam layer which is placed on the wall of the pipe." (Official Action, pg. 7). However, it is respectfully submitted that this characterization of the problem solved by the present invention is far too broad. The field of the present invention is insulated pipelines (see application, pg. 1, line 10). Specifically, claim 1 recites a method of applying syntactic foam insulation to a length of pipe. The method of claim 1 includes the step of: "solidifying said thermoplastic protective cover to retain said syntactic foam insulator in a desired shape about the length of pipe." (emphasis added, cl. 1). Again, Doucet can not be properly considered to be the field of the present invention, since it does not involve the field of insulated pipe. There is of course of no need for an insulation in a sewage or drainage pipe, because only waste is flowing through the pipe.

Therefore, it is respectfully submitted that the '163 Application and Doucet are not properly combinable.

11. Claims 4-5 and 10 currently stand rejected for allegedly being obvious in view of the '163 Application in combination with the subject matter disclosed in U.S. Patent 4,364,882 to Doucet (hereinafter "Doucet"), further in combination with the subject matter disclosed in U.S. Patent 4,773,448 to Francis (hereinafter "Francis").

It is respectfully submitted that this rejection is now moot since claims 1 and 9 are patentable for at least the reasons set forth above.

For all the foregoing reasons, reconsideration and allowance of claims 1, 4, 5, 8-10 and 12 is respectfully requested.

If a telephone interview could assist in the prosecution of this application, please call the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, reading "Patrick O'Shea", is written over a horizontal line.

Patrick J. O'Shea
Reg. No. 35,305
Samuels, Gauthier & Stevens, LLP
225 Franklin Street, Suite 3300
Boston, MA 02110
(617) 426-9180, Ext. 121



VERSION WITH MARKINGS TO SHOW CHANGES MADE TO CLAIMS

Amend claim 8 as follows:

- 1 8.(Twice Amended) The method of claim 1, wherein said step of [rapidly] solidifying
- 2 comprises the step of air cooling said thermoplastic protective coating.